

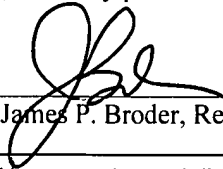
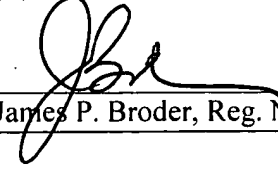
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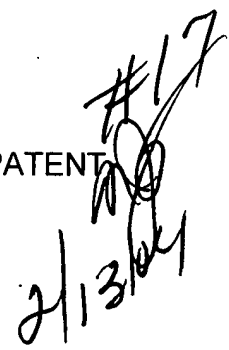
FEB 12 2004

Rev. 10/1/03

2652

Technology Center 2600

<b>RESPONSE TRANSMITTAL LETTER</b>			Attorney Docket Q01-1037-US1 / 11198.62			
Application Serial Number:	Filing Date:	Examiner:	Group Art Unit:			
10/029,112	October 19, 2001	William J. Klimowicz	2652			
Invention: MULTI-RECEIVER CARTRIDGE TRANSPORT SYSTEM						
<b>TO THE COMMISSIONER OF PATENT AND TRADEMARKS:</b> Transmitted herewith is an amendment in the above-identified application. The fee has been calculated as shown below.						
<b>CLAIMS AS AMENDED</b>						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	NUMBER OF EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	40	MINUS	40	0	\$18	\$0
INDEP. CLAIMS	5	MINUS	5	0	\$86	\$0
<p>___ Petition is hereby made under 37 CFR 1.136(a) to extend the time for response to the Office Action of _____ to and through _____, comprising an extension of the shortened statutory period of:</p> <p>___ one month (\$110)      ___ three months (\$950) ___ two months (\$420)      ___ four months (\$1,480)</p>						
<b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT</b>						<b>\$0</b>
<p>___ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.</p> <p>___ A check in the amount of \$ _____ [which includes \$ _____ for the _____] is enclosed.</p> <p><input checked="" type="checkbox"/> The commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-1141, pertaining to 1) any filing fees under 37 CFR 1.16 for the presentation of extra claims; 2) any patent application processing fees under 37 CFR 1.17.</p> <p><input checked="" type="checkbox"/> Any additional extension of time required for the timely submission of this paper, the fees for which have not been previously paid, is hereby petitioned for and requested.</p> <p><u>2/4/2004</u> Date</p> <p> James P. Broder, Reg. No. 43,514</p>						
CERTIFICATE OF MAILING: I hereby certify that this correspondence and all correspondence identified as accompanying this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop No Fees, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 4, 2004.						
 James P. Broder, Reg. No. 43,514						



) Art Unit  
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**Mail Stop No Fee Amendment**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

In response to the Notice of Non-Responsive Amendment/Response dated January 15, 2004, having a shortened statutory period for response set to expire on February 15, 2004, please substitute the present Response to Non-Responsive Amendment/Response for the previously filed Amendment and Response to Election Requirement dated October 28, 2003, as provided below.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop No Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this the 4<sup>th</sup> day of February, 2004.

JAMES P. BRODER, Attorney for Applicant--Registration No. 43,514

### **ELECTION**

The Applicants respectfully elect with traverse the claims of Species II, and Sub-species IIa, which Applicants believe comprises at least claims 32, 34-47 and 49-61. Applicants further respectfully submit that at least claims 32, 34-36, 39-45, 49 and 50 are generic claims which read on each of the Species I and II as defined by the Patent Office.

### **ARGUMENT**

The Applicants respectfully traverse the election requirement with respect to election of a single species and sub-species as defined by the Patent Office. The Patent Office has determined that the "application contains claims directed to the following patentably distinct species of the claimed invention: Specie I drawn to a transport assembly having a cartridge mover including a pass-through assembly; Specie II drawn to a transport assembly having a cartridge mover including at least one gripper; Subspecie IIa - drawn to the transport assembly having a cartridge mover of Specie II wherein there is a second gripper that moves perpendicular to the first gripper; Subspecie IIb – drawn to the transport assembly having a cartridge mover of Specie II wherein there is a second gripper that moves parallel to the first gripper." As set forth below, the Applicants submit that the restriction requirement is improper and should be withdrawn as explained below.

As stated in the guidelines of the MPEP for section 803, "examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases. Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement." (Guidelines, MPEP 803). Additionally, "for purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02." (Guidelines, MPEP 803). In the present action, the Applicants respectfully submit that the Patent Office has not adequately demonstrated reasons or examples to support its conclusions. Moreover, the Patent Office has not provided any explanation of separate

classification for the separate status in the art for the Species and the Sub-species, or that a different field of search is required to examine the restricted claims of together in one application.

Even where different species can be shown to be patentably distinct by the Patent Office, as set forth in MPEP 803, "there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent; and
  - (B) There must be a serious burden on the examiner if restriction is required."
- (MPEP 803).

First, the inventions are not independent as defined by the MPEP. "The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, ... ." (MPEP 802.01).

The Patent Office appears to have drawn a distinction between the cartridge movers which use a pass-through assembly versus a gripper. However, the structural components included in the embodiments provided in the restricted claims are not completely "unconnected in design, operation, or effect." These embodiments, as supported by the specification, can perform essentially similar functions. For example, either cartridge mover can move a cartridge between a transporter and a storage rack and/or a tape drive. (See, for example, page 4, lines 23-26; page 11, lines 11-16; and page 14, lines 13-23). Moreover, the cartridge mover that includes a pass-through assembly for a first transport receiver can also include a gripper that is used for a second transport receiver, or vice versa. In other words, because the cartridge gripper disclosed in the specification can be used to move cartridges to and/or from a plurality of transport receivers, a first transport receiver can use a gripper, and a second transport receiver can use a pass-through assembly. The Applicants submit that one skilled in the art would read the present application as providing an embodiment that includes a pass-through assembly for one transport receiver and a gripper for the other transport assembly, and that such construction is not "hypothetical" and is wholly consistent with the other

embodiments disclosed in the specification.

Consequently, although the Applicants strongly believe that all of the claims are generic, for the purpose of responding to the Notice of Non-responsive Amendment/Response by the Patent Office, the Applicants provide that at least claims 32, 34-36, 39-45, 49 and 50 are generic. The Applicants maintain their position that separate "species" are not necessarily warranted for the embodiments described in the restricted claims. Accordingly, the Applicants submit that examining the embodiments encompassed by Species I and Species II can potentially be performed together without conducting an additional search.

Additionally, the Applicants respectfully disagree with the segregation of Sub-species by the Patent Office. First, the terminology used by the Patent Office is inconsistent with the terminology of the claims. For example, the claims do not reference a "gripper". Some of the claims refer to a "gripper mover" and/or a "gripper assembly". Therefore, the terminology of the restriction requirement by the Patent Office is confusing and difficult to understand.

Assuming the Patent Office intended to refer to the "gripper mover", although many or all of the claims do not preclude the use of a second gripper mover that moves parallel to the direction of the first gripper mover, none of the claims specifically use the term "parallel" in the context of the first gripper mover and the second gripper mover. Thus, the Applicants submit that the subdivision of Species II into Sub-species IIa and IIb is misplaced, and should be withdrawn. Consequently, the Applicants believe that either Subspecies is readable on all of the pending claims. However, for the purpose of responding to the Notice of Non-responsive Amendment/Response by the Patent Office, the Applicants submit that at least claims 32, 34-47 and 49-61 read on Subspecies IIa.

Based on the foregoing, the Applicants assert that the election requirement with respect to the Species and Sub-species is improper, and should be withdrawn. Consequently, the Applicants respectfully submit that claims 22-61 should be examined together as required by MPEP 802.01 and 803.